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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/505,312	08/10/2005	Todd A. Loeffelholz	02316.1662USWO	6009
23552	7590	07/06/2006	EXAMINER	
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			HARRIS, ANTON B	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/505,312	Applicant(s) LOEFFELHOLZ ET AL.	
	Examiner Anton B. Harris	Art Unit 2831	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 24-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/20/04</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 24-27, 38-40, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by Anderson et al. (5,909,155).

Regarding claim 24, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a module comprising a housing 12 having a front wall 14 and a rear wall 16, the front wall 14 including a conductive material; rear connectors 40-0 to 40-8 mounted at the rear wall 16; and at least one receptacle 38 defined through the front wall 14, the receptacle 38 having a depth of sufficient magnitude to choke emissions generated within the housing 12.

Furthermore, the limitation of “for receiving a circuit component” in claim 24 has been considered, but does not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 25, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a front connector 41 positioned within the housing 12.

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Furthermore, the limitation of “for interfacing with the circuit component” in claim 25 has been considered, but does not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Furthermore, the limitation of “adapted to guide the circuit component into the front connector” in claim 25 has been considered, but does not result in a structural difference. It has been held that a recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 26, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a plurality of the receptacles (60-1 to 60-8), each receptacle (60-1 to 60-8) having a depth of sufficient magnitude to choke emissions generated within the housing 12.

Furthermore, the limitation of “for receiving a plurality of circuit components” in claim 26 has been considered, but does not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 27, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a front wall 14.

Furthermore, the limitation of “configured to choke RF emissions to a level such that the module radiates signals that are 100 db down or better from a carrier across a frequency range of

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5 megahertz to 1 gigahertz, even in the absence of covers” in claim 27 has been considered, but does not result in a structural difference. It has been held that a recitation that an element is “configured to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claims 38 and 40, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses that the module 10 comprises splitter/combiner module (abstract) and includes splitter/combiner circuitry (abstract), and wherein the circuit component comprises an attenuator pad (abstract).

Regarding claim 39, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a module comprising a housing 12 having a front wall 14 and a rear wall 16, the front wall 14 including a conductive material; rear connectors 40-0 to 40-8 mounted at the rear wall 16; a front connector 41 positioned within the housing 12 adjacent to an interior side of the front wall 14; and at least one receptacle 38 defined through the front wall 14 at a location in alignment with the front connector 41, the receptacle 38 being defined by one or more guide surfaces.

Furthermore, the limitation of “for connecting with a circuit component” and “adapted for guiding the circuit component through the front wall and into contact with the front connector” in claim 39 have been considered, but do not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Regarding claim 44, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a module comprising a housing 12 having a front wall 14 and a rear wall 16, the front wall 14 including a

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conductive material; rear connectors 40-0 to 40-8 mounted at the rear wall 16; a receptacle 38 defined through the front wall 14; an attenuator pad (abstract) received within the receptacle 38; and a cover 100, the cover being.

Furthermore, the limitation of “for covering the attenuator pad” in claim 44 has been considered, but does not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Also, the limitation of “configured such that an attenuation value provided on the attenuation pad can be determined without removing the cover” in claim 44 has been considered, but does not result in a structural difference. It has been held that a recitation that an element is “configured to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various

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claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 28-32 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al.

Regarding claims 28, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a module 10 having depth, but lacks a module having a depth greater than .15 inches.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing a module having a depth greater than .15 inches, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 29, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a module 10 having depth, but lacks a module having a depth at least .2 inches.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing a module having a depth at least .2 inches, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 30, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses a module 10 having depth, but lacks a module having a depth at least .3 inches.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Anderson et al. by providing a module having a depth at least .3 inches, since it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Regarding claim 31, Anderson et al. discloses a cover 100.

Furthermore, the limitation of “adapted to be mounted over the receptacle” in claim 31 has been considered, but does not result in a structural difference. It has been held that a recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 32, Anderson et al. (col. 5, lines 26-38) discloses that a cover 100 includes metal.

Regarding claim 42, Anderson et al. (col. 3, line 6-col. 4, line 62) discloses that the module 10 comprises splitter/combiner module (abstract) and includes splitter/combiner circuitry (abstract), and wherein the circuit component comprises an attenuator pad (abstract).

5. Claims 33-37, 41, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. in view of Vogeles (4,873,600).

Regarding claim 33, Anderson et al. discloses the invention substantially as claimed, but lacks a cover made of a nonconductive material.

It is well known in the art to use of nonconductive plastic materials in electrical housings depending on the desired properties of the housing being constructed. Vogeles teaches the use of a nonconductive plastic material to form a junction box or “utility station” 10 in order to prevent

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excessive corrosion in a harsh marine environment. See in particular the discussion at column 3 lines 39-47 in Vogelee.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cover of Anderson et al. from a nonconductive plastic material in order to prevent corrosion due to moisture or humidity in the environment in view of the teaching of Vogelee.

Regarding claim 34, Anderson et al. discloses the invention substantially as claimed, but lacks a cover including plastic.

It is well known in the art to use plastic materials in electrical housings depending on the desired properties of the housing being constructed. Vogelee teaches the use of a plastic material to form a junction box or “utility station” 10 in order to prevent excessive corrosion in a harsh marine environment. See in particular the discussion at column 3 lines 39-47 in Vogelee.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cover of Anderson et al. from a plastic material in order to prevent corrosion due to moisture or humidity in the environment in view of the teaching of Vogelee.

Regarding claims 35 and 43, Anderson et al. discloses the invention substantially as claimed, but lacks a cover including at least a portion that is transparent.

It is well known in the art to use plastic materials to create transparent portions in electrical housings depending on the desired properties of the housing being constructed. Vogelee teaches the use of a plastic material to form a junction box or “utility station” 10 in order to

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prevent excessive corrosion in a harsh marine environment. See in particular the discussion at column 3 lines 39-47 in Vogelee.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cover of Anderson et al. from a plastic material including at least a portion that is transparent in order to prevent corrosion due to moisture or humidity in the environment in view of the teaching of Vogelee.

Regarding claim 36, Anderson et al. (col. 4, lines 62-67) discloses an attenuator pads.

Regarding claim 37, Anderson et al. (figure 1) discloses a cover 100.

Furthermore, the limitation of “for covering the attenuator pads” in claim 37 has been considered, but does not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Furthermore, the limitation of “configured such that attenuation values of the attenuator pads can be determined without removing the cover from the housing” in claim 37 has been considered, but does not result in a structural difference. It has been held that a recitation that an element is “configured to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

Regarding claim 41, Anderson et al. discloses a module 10 comprising a housing 12 having a front wall 14 and a rear wall 16, the front wall 14 including a conductive material; rear

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connectors 40-0 to 40-8 mounted at the rear wall 16; at least one receptacle 38 defined through the front wall 14; and a non-metallic cover 100, but lacks a non-metallic cover.

It is well known in the art to use plastic materials in electrical housings depending on the desired properties of the housing being constructed. Vogeles teaches the use of a plastic material to form a junction box or "utility station" 10 in order to prevent excessive corrosion in a harsh marine environment. See in particular the discussion at column 3 lines 39-47 in Vogeles.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the cover of Anderson et al. from a non-metallic material in order to prevent corrosion due to moisture or humidity in the environment in view of the teaching of Vogeles.

Furthermore, the limitations of "for receiving a circuit component" and "for covering the receptacle" in claim 41 have been considered, but do not result in a structural difference. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Glover U.S. Patent No. 6,242,690 discloses an EMI shielding including a cover and receptacles.

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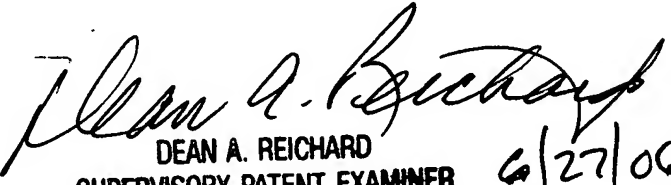
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anton B Harris whose telephone number is (571) 272-1976. The examiner can normally be reached on weekdays from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr.

Dean Reichard, can be reached on (571) 272-2800 ext 31. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

abh

6/26/06


DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800 6/27/06